

REMARKS

In the Office Action dated July 17, 2009, claims 1-39 and 85 were pending. Claims 1-39 and 85 were rejected. Claims 1-39 and 85 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dwyer, FR, “Customer Lifetime Valuation to Support Marketing Decision Making”, 1997, Journal of Direct Marketing, Volume 11, Issue 4, John Wiley & Sons, pp. 6-13. (hereinafter Dwyer) in view of “Quantitative approaches for profit maximization in direct marketing”, 1998, H van der Scheer – dissertations.ub.nl (hereinafter Scheer).

Claims 1-39 and 85 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dwyer, FR, “Customer Lifetime Valuation to Support Marketing Decision Making”, 1997, Journal of Direct Marketing, Volume 11, Issue 4, John Wiley & Sons, pp. 6-13. (hereinafter Dwyer) in view of “Quantitative approaches for profit maximization in direct marketing”, 1998, H van der Scheer – dissertations.ub.nl (hereinafter Scheer). Applicants respectfully traverse this rejection.

Furthermore, Applicants amend the independent claims 1, 14, 27, and 85 to require that *“determining, using the processor, a return on investment of the direct a mail marketing campaign [be] based on: the production cost, the shipping service cost, and the financial information”*. Applicants submit that the financial information, as defined by Dwyer is different than is claimed here, they nevertheless amend their claims here to require that all three types of data be required for determining a ROI, in order to expedite allowance of these claims. Neither of the two references disclosed basing a return on investment determination on production costs or shipping service costs. Furthermore, Dwyer does not calculate ROI at all, but rather a Lifetime Valuation (LTV). These elements are missing from the cited references.

Applicants respectfully submit that a prima facie case of obviousness has not been made for these independent claims, that the rejection of these claims as obvious is improper, and request that the rejection be withdrawn. The remainder of the claims are dependent upon these four independent claims, and should therefore be allowable for the same reasons.

Furthermore, in regards to the rejection of Claims 2-6, 15-19, and 28-32, MPEP § 2143 requires that: “** *"All words in a claim must be considered in judging the patentability of that claim against the prior art."* In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). *If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”

The examiner has effectively read the limitations in these claims out of them. Applicants respectfully submit that the examiner cannot ignore these claims and their limitations by asserting that the recited method claims would be performed the same regardless of the actual data, that the structural materials might remain the same regardless of the specific data, or that the specific descriptive data would not distinguish the claimed invention from the prior art in terms of patentability. This ignores that the sources of the different types of data are different, that the data is not merely descriptive, but also functional, in terms of the results generated by the invention, that method claims may be distinguished through structure, and that the same rejection is being made for three different statutory classes of invention, while any such rejection is only relevant to one such statutory class.

Applicants respectfully submit that these dependent claims are dependent upon allowable claims, that claimed elements are missing from the combined references, that a prima facie case of obviousness has not been made, that this rejection of these claims is improper, and request that it be withdrawn.

Applicants believe that the above-identified application is now in condition for allowance and such action is respectfully requested.

If the Examiner has any questions regarding this application or this response, the Examiner is requested to telephone the undersigned at 775-586-9500.

Respectfully submitted,
LEWIS AND ROCA LLP

Dated: September 17, 2009

/bruce e. hayden/

Bruce E. Hayden
Reg. No.: 35,539

Lewis and Roca LLP
1663 Hwy 395, Suite 201
Minden, NV 89423
(775) 586-9500